



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/039,342

11/19/2001

Richard L. Borders

8266-0738

1486

7590

12/22/2004

Timothy E. Niednagel
Bose McKinney & Evans LLP
Suite 2700
135 N. Pennsylvania Street
Indianapolis, IN 46204

EXAMINER

LEE, BENJAMIN C

ART UNIT

PAPER NUMBER

2632

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,342

Applicant(s)

BORDERS ET AL.

Examiner

Benjamin C. Lee

Art Unit

2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2002 and 18 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-10, 13-16 and 18-34 is/are allowed.
- 6) ☒ Claim(s) 12 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Claim Rejections - 35 USC § 103

1. Claims 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gombrich et al. (US pat. #4,857,716) in view of Snell (US pat. #5,749,908) and White et al. (6,353,413).

1) In considering claim 12:

Gombrich et al. discloses an integrated personal communication and data entry device (Figs. 11, 21, 25-26 and 35) comprising: a portable housing (322 of col. 22, line 20); an internal controller (364 of col. 23, lines 6-7) coupled to the housing; a communication device (RF modem 366; communications port 368 of col. 23, lines 9-15) coupled to the controller; and an information device coupled to the controller, wherein the information device is configured to transmit patient identification information to a hospital data system to enable storage of said information from the information device related to a patient on the hospital data system (vital signs measurement equipment and patient identification optical sensor device 352 according to col. 23, lines 15-45; col. 22, lines 3-5; and hospital system of Fig. 1 comprising computer system 42 and memory devices 44).

Snell teaches an integrated portable device comprising a voice recording device coupled to a controller, wherein the voice recording device is configured to obtain and enable storage of voice information from the voice recording device related to a patient data set as voice annotation, whereby the patient information is linked to a hospital data system for storage (Abstract; elements 100, 153 & 178 of Figs. 1-2 and 3/23).

White et al. teaches a multi-functional, integrated personal communication and data entry device (UC 10 - pager/cellular phone & PDA/PC - col.3 lines 22-35) which comprises a paging device (pager - col.3 lines 22-35) coupled to a portable housing (rectangular box) enclosing a controller (computer 70).

In view of the teachings of Gombrich et al., Snell and White et al., it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include a voice recording device of Snell in a multifunctional integrated portable device such as taught by Gombrich et al. in order to provide voice annotations to the patient data set such as vital signs data as additional patient information for transmission and storage as patient records in the hospital data system to thereby provide detail and meaning to the patient data, and furthermore to include a paging device as taught by White et al. in such a multifunctional integrated portable device to allow remote paging capability which paging has been known to be used often in the patient/hospital environment.

2) Regarding claim 17, Gombrich et al., Snell and White et al. render obvious all of the claimed subject matter as in the consideration of claim 12, including:

a) the claimed output device ("status lights" 358 in Fig. 29 of Gombrich et al.);

except:

b) the claimed wherein the integrated device is configured to provide at least one prompt on the output device to record at least one predetermined category of patient status information.

However, since the voice recorder of Gombrich et al., Snell and White et al. are used to annotate patient data sets as complementing patient data and since the status lights on the portable device are used for providing status indications including prompts, it would have been

Art Unit: 2632

obvious to one of ordinary skill in the art at the time of the claimed invention to use a standardized patient data set annotation procedure implemented by prompting a user to annotate and record at least one predetermined category of patient status information in a check-list format in order to help a user in the entry of annotations in a consistent and predetermined manner.

Allowable Subject Matter

2. Claims 1-10, 13-16 and 18-34 are allowed.

Response to Arguments

3. Applicant's arguments filed 6/18/04, with respect to claims 1-10, 13-16 and 18-34 have been fully considered and are persuasive. The rejection of claims 1-10, 13-16 and 18-34 has been withdrawn. However, upon further consideration, claims 12 and 17 have been rejected under new grounds in the above rejection. See above rejection for detail.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US pat. #s 4610254, 5683423, 5877675, 5921938

--Similar use of voice recordation/communication on a portable medical device.


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (571) 272-2963.

The examiner can normally be reached on Mon -Fri 11:00Am-7:30Pm.

Art Unit: 2632

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin C. Lee
Primary Examiner
Art Unit 2632

B.L.